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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,657	01/23/2002	Mary E. Goulet	CK 4154	5506

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,657	GOULET ET AL.	
	Examiner	Art Unit	MW
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-18 been renumbered as 2-19.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8, 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8. The term "may" implies a potential capability, not an actual method step, thereby making the claim indefinite.

Claim 14. Simultaneous use of terms "unless" and "until" is confusing. The term "unless" indicates an optional condition, while the term "until" indicates a mandatory condition.

Claim 17. Simultaneous use of terms "and" and "or" is confusing. The term "and" indicates a mandatory condition, while the term "or" indicates an optional condition.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 9-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Narang (US 2001/0025296 A1).

Narang teaches a method and system for creation a music work over a computer network, comprising:

Claim 1. Posting musical scores for musical works on the Internet; providing public access to said posted musical scores [0007]; [0009].

Claim 2. See claim 1. Information as to *a new musical theatre show under development and not yet performed live* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Narang would be performed the same regardless of the type of the musical work.

Claim 9. Posting musical scores for musical works on the Internet [0007]. Information as to *the music in written notation comprises sheet music with words* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 10. Posting musical scores for musical works on the Internet [0007]. Information as to *at least two audio-recorded e-audition songs each comprising a version of the music for which access was provided* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 11. Posting the objectives (musical works) electronically via a submission form posted on the Internet website [0009].

Claim 12. Providing an automatic voting counter for the posted musical works [0036].

Claim 13. Said method, wherein providing an automatic voting counter further comprises: transmitting e-mail to participants inviting them to take part in evaluation and scoring [0034], thereby inherently indicating *identifying an email address that submitted a vote.*

Claim 15. Said system including: an Internet website, a plurality of posted musical works and a voting counter [0007]; [0009]; [0036].

Claim 16. Said system including a display [0017] (browsing the Internet inherently indicates use of a display). Information as to *display of voting data* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 16 including *a display* are disclosed in Narang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 17. Said system including a display [0017] (browsing the Internet inherently indicates use of a display). Information as to *the display for showing a numerical-vote and/or a percentage-of-the-vote showing* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 17 including *a display* are disclosed in Narang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang.

Claims 3. Narang teaches all the limitations of claim 3, except explicitly teaching that said musical work is printable onto paper by a website visitor.

Official notice is taken that printing from the Internet is well know.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include that said musical work is printable onto paper by a website visitor, because it would allow said visitor to keep a hard copy of said musical work, thereby working on said musical work at any convenient for said visitor time and place.

Claims 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Sherman et al. (US 2002/0051119 A1).

Claim 4. Narang teaches all the limitations of claim 4, except that when the musical work is printed onto paper, a restrictive legend is printed behind the music.

Sherman et al. (hereinafter Sherman) teaches a method and system for customizing a motion film selection, wherein a movie clip including a soundtrack and music score [0027]-[0028] are downloaded via the Internet so that participants can record their own versions of soundtracks and submit them to a Web site [0038], and wherein watermark technology is used to encode the downloaded material [0032].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include providing a restrictive technology for protecting the intellectual properties, as disclosed in Sherman, because it would prevent the illegal distribution of said musical works.

Claim 6. Sherman teaches: maintaining on the Internet a Web site to which the recorded versions of the soundtracks are submitted [0038] obviously indicates publicizing said Web address.

Claim 7. Sherman teaches said method, wherein said publicized address comprises an email address [0039].

Claim 8. Narang teaches: providing on the Internet site a form screen into which a submitter may type responsive information [0009].

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Miles et al. (US 6,102,406).

Claim 5. Narang teaches all the limitations of claim 5, except that when the musical work is printed onto the paper, the website domain name is printed onto the paper.

Miles et al. (hereinafter Miles) teaches a method and method for Internet-based advertising scheme, wherein any print out of a Web page will automatically include a domain name (C. 7, L. 19-23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include printing a domain name on the Web page print out, as disclosed in Miles, because it would promote a name of the Web page content provider.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Karro et al. (US 2002/0077885 A1).

Claim 14. Narang teaches all the limitations of claim 14, expect teaching that when a participant submits a vote for a first musical work, the voting counter counts the vote until the participant votes for a second musical work, in which case the voting counter subtracts the vote by the submitting a vote for the first musical work and counts the vote for the second musical work.

Karro et al. (hereinafter Karro) teaches a method and system for electronic voting system, wherein, if a user resubmits his/her vote, an authenticator throws out the old vote and keeps the new one [0197].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include subtracts the first vote if the participant resubmits his/her vote and counting the second vote for the second musical work, as disclosed in Karro, because it would allow to avoid duplicate votes thereby enhance accuracy of the voting arrangement.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Mengerink et al. (US 2002/0073174 A1).

Claim 18. Narang teaches all the limitations of claim 20, except teaching un-posting a musical work which received relatively low total votes and/or relatively low percentage-of-the vote.

Mengerink et al. (hereinafter Mengerink) teaches a method and system for creating a customized Internet site, wherein users ratings of the posted content are used to remove unpopular features from the site [0022] and [0025].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include un-posting unpopular musical work, which received relatively low users rating, as disclosed in Mengerink, because it would decrease expenses for site maintenance.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Barnes, JR. (US 2003/0065805 A1).

Claim 19. Narang teaches all the limitations of claim 19, except teaching that said posting of musical works is conducted in order of submission with a most recently received submission at the top.

Barnes, JR. (hereinafter Barnes) teaches a method and system for providing location based services in e-commerce environment, wherein employment offerings are posted on web sites so that most recent job postings are at the top of a list [0363].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include that said posting of musical works is conducted in order of submission with a most recently-received submission at the top, as disclosed in Barnes, because it would allow visitors to quickly locate the most recent posting, thereby save visitor's time.

Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Ghani (US 2002/0085030 A1).

Claim 20. Narang teaches all the limitations of claim 20, expect teaching that said posting of musical works further includes posting next to a posted musical work, public identifying information as specified by the submitter of the musical work.

Ghani teaches a method and system for a graphical user interface (GUI) for an interactive collaboration system, said GUI includes a comment box within which a posted messages are displayed, and an audience text box within which a list identifying each participant is displayed [0007].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include posting next to a posted musical work, public identifying information, as disclosed in Ghani, because it would allow the

participants to identify individuals providing useful information and, further, contact them.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The following U.S. patents are cited to further show the best domestically patented prior art found by the examiner:

US 2002/0198763 A1 to Pittelli discloses a system for determining a market demand based on consumer contributions.

US 6,529,873 B1 to Owen discloses a system for effecting production, approval and downloading of audio programs via the Internet.

US 6,243,740 B1 to Minneman et al. teaches a method for publicly co-creating a document.

US 2003/0188625 A1 to Tucmandl teaches a system for composing a musical composition.

US 2002/0101454 A1 to Hong teaches a compact disc containing combined video and audio information.

The following foreign patent is cited to show the best foreign prior art found by the examiner:

EP 1164504 A2 to Hayashi et al. teaches a system for broadcasting requested pieces of music utilizing information system.

JP02002099283A to Takizawa, appears to disclose a system for distributing pieces of music.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

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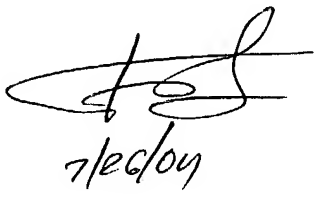
Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629



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